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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,616	12/07/2000	Jeffry Grainger	20313-000500US	4192
20350	7590	05/23/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/733,616	Applicant(s) GRAINGER, JEFFRY	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17, 19-23 and 32-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17, 19-23, 32-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 25, 2005, wherein:

Claims 11-17, 19-23, 32-64 are currently pending;

Claims 1-10, 18, and 24-31 have been cancelled;

Claims 11-15, 17, 19-23, 32-36, and 38-44 have been amended;

Claims 45-64 have been added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2005 has been entered.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on February 25, 2005 are being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3629

4. Claims 17, 19, 38-40, 45-46, 46, 55, 57 and 60 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 45, the applicant claims a method in the preamble but recites structure in the body of the claims as "a computer providing an interface for a user" and "the computer allowing a user to identify." The Examiner is interpreting this as providing a computer interface for a user and allowing a user to identify via a computer interface at least one relevant document.

In claim 46, the applicant states that the transmission of the statement comprises printing the statement for mailing. However, the applicant does not claim any transmission, e.g., the applicant does not mail the document.

In claim 55, it is unclear how transmission of the statement to the office is accomplished by inserting into the document a set of information from the linked document. Where is the transmission? Furthermore, it appears that the electronic document is being inserted into itself, e.g., applicant states that inserting into the electronic document a set of information from the linked electronic document.

In claim 57, it is unclear how transmission of the statement to the patent office comprises filtering information such that the statement comprises the information. How is considered to be providing transmission?

In claims 19 and 40, it is unclear how the computer makes the determination that a patent application is being filed.

Art Unit: 3629

In claim 60, it is unclear how a disclosure statement is configured to be filed to fulfill a patent applicant's duty to disclosure in the official patent office. It appears that applicant is stating that the statement meets the requirements of the patent office in which it is filed.

In claims 17 and 38, where do the instructions come from?

In claim 39, it is unclear how the computer instructs the transmission.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-17, 19, 33, 37-40, 45-51, 60-61, and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi et al (US 6,049,811) in view of Tran (US 2001/0049707).

Regarding Claims 45, 63 and 64:

Petruzzi disclose a method, system and software program for generating an information disclosure statement comprising:

a processor (Figure 1 - col. 4, lines 40-51 processor operates to control the program within the computer 10) and a computer readable memory (ROM/RAM col. 4, lines 40-51) with a computer software program embodied on the memory in

Art Unit: 3629

communication with the processor for providing instructions executable by the computer to:

providing a computer interface for a user to review at least one electronic document that is relevant to a patent application (Figure 1 (12) display; col. 5, line 48 thru col. 6, line 7);

allowing a user to identify via the computer interface the at least one relevant electronic document for disclosure to a patent office (col. 5, line 48 thru col. 6, line 7 through the use of a wizard, the operator is prompted for references);

incorporating at least some information from the electronic document into an electronic information disclosure statement in a form suitable for filing with an official patent office via the computer Figure 2 (Forms 39) col. 5, line 48 thru col. 6, line 7 The Form 1449 for submitting information in the form of patents, publications, etc is provided, operator is prompted for references, a brief description of each reference and the relevance. After information is inputted, the computer automatically generates a first draft).

Petruzzi does not disclose providing for the transmission of the statement to an official patent office.

However, Tran discloses providing for the transmission of the statement to an official patent office (Figure 2C File application, [0007 generation and filing of a complete patent application [0017] techniques support electronic patent filing).

Art Unit: 3629

Regarding Claim 46:

Tran discloses the transmission of the statement comprises printing and mailing ([0046] Express Mail Declaration, correct Mailing Label Number).

Moreover, the Examiner takes Official Notice that transmission of patent documents via mail to the office is old and well known as is evidenced by the fact that it was an established business principle to use a certificate of mailing when mailing applications to the office.

It would have been obvious to one of ordinary skill in the art at the time of the invention to print and mail the application since it was known in the art that mailing was a reliable way of transmitting the application, including the IDS, and for many years was the only way to transmit the application, including the IDS, without having to hand deliver the papers.

Regarding Claim 47:

Tran discloses wherein the transmission comprises transmitting the statement electronically to the office ([0017] [0048] [0049]).

Regarding Claim 48:

The Examiner takes Official Notice that the selection of the relevant document comprising browsing the Internet and finding the document is old and well known as is evidenced by the fact that examiners in the patent office often search the Internet Archive Wayback Machine to find prior art.

Art Unit: 3629

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include searching the Internet to find prior art documents since many of the applications involve processes performed over the Internet and thus a thorough search would involve searching the Internet.

Regarding Claim 49:

The Examiner take Official Notice that selecting the relevant document from a database of documents to find at least one relevant document is old and well known as is evidenced by the numerous databases affiliated with the various patent offices and other commercial search databases. Applicants can access the databases on the website of the PTO and make a search of prior art from the PTO website database.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to search a database of documents to find relevant documents since much of the prior art is stored in patent office databases and other commercial databases and a thorough search for relevant prior art could only be performed by searching such databases.

Regarding Claim 50:

Petruzzi discloses wherein the incorporating at least some information from the document into the electronic information disclosure statement comprises:

extracting via the computer a relevant portion of a set of reference information from the document (col. 5, line 48 thru col. 6, line 7 - computer 10 automatically

Art Unit: 3629

generates a first draft information disclosure state by adding appropriate phrases and formatting); and

inserting via the computer the relevant portion of the set of references into the electronic document (col. 5, line 48 thru col. 6, line 7).

Regarding Claim 51:

Petruzzi discloses wherein extracting a relevant portion comprises allowing the user to select a relevant portion (col. 5, line 48 thru col. 6, line 7; and

providing the user with an option to insert the selected portion into the statement (col. 5, line 48 thru col. 6, line 7 – operator is prompted for references, a brief description of each reference, and the relevance of each reference).

Regarding Claims 19, 39, 40 and 59:

See the discussion under Claim 47 – the document can be transmitted directly using an on-line communication.

Regarding Claim 60:

The Examiner takes Official Notice that an Information Disclosure Statement is a related but separate document to a patent application and must meet the requirements of a disclosure statement of the patent office in which it is filed. (See Petrucci (col. 5, line 48 thru col. 6, line 7 discloses Form 1449 (IDS) and col. 16, lines 34-39 – Petrucci can be modified to incorporate the patent laws and rules of any foreign country)

Art Unit: 3629

Regarding Claim 61:

Petruzzi discloses receiving a set of general information from the user to be incorporated into the statement (col. 5, line 48 thru col. 6, line 7 operator is prompted for references, a brief description of each reference and the relevance).

Regarding Claims 16, 33 and 37:

Tran discloses prompting the user for an access code when the user requests access to the statement ([0019] users are logged in) and access to the statement is provided to multiple users over a network [Figure 1 [0043] one or more client workstations are connected).

Regarding Claims 17 and 38:

Tran discloses providing the user with instructions as to when a document is to be disclosed ([0041] user is prompted to list any publication or planed disclosure of the invention).

6. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi and Tran as applied to claim 50 above, and further in view of Nagashima et al (US 5,778,398) (hereinafter referred to as Nagashima).

Regarding Claim 52:

Petruzzi and Tran do not disclose dragging and dropping.

Art Unit: 3629

However, Nagashima discloses allowing the user to drag a relevant portion of the information from the electronic document into the statement (col. 7, lines 31-39 and col. 8, lines 2-12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the dragging of Nagashima with the disclosures of Petruzzi and Tran so as to provide a document processing which permits a plurality of document elements to share contents in respective document structures while maintaining the consistency to the change of content.

7. Claims 53 and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi and Tran as applied to claim 50 above, and further in view of Jammes et al (US 6,484,149) (hereinafter referred to as Jammes).

Regarding Claim 53:

Petruzzi and Tran do not disclose parsing the document for a relevant portion of reference information.

However, Jammes discloses a method wherein the extracting comprises parsing (col. 7, lines 15-53, col. 17, line 62 thru col. 18, line 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine parsing as taught by Jammes with the IDS form of Petruzzi so as to provide a graphical user interface which displays information and links information content within documents.

Art Unit: 3629

Regarding Claim 56:

Jammes discloses wherein incorporating comprises storing the document in the statement (col. 5, line 65 thru col. 6, line 4 – a hyperlink form one document to another, or from one portion (or component) or a document to another)

Regarding Claim 57:

Jammes discloses a method wherein the transmission comprises filtering (extracting) a set of relevant information (col. 17, line 62 thru col. 18, line 5 extracts the query form the message and passes extracted query to query application).

Furthermore, the Examiner takes Official Notice that filtering is performed when performing a search for relevant documents, with the search engine filtering or extracting out the relevant documents. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate filtering into any application where one is searching for the relevant prior art relevant to an invention which is being filed in the patent office so as to provide only that which applies to the application and since the use and advantage of the step of filtering are well known, ie, prevent the reporting of information that is not relevant. (Also, see Tran [0088] the portal has access to IP search engines that continuously search the web and identify information that is of interest to its users suing the profiles to search (filters out contents that is not of interest to the subscribers)

Art Unit: 3629

8. Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi and Tran as applied to claim 45 above, and further in view of Porcari (US 2001/0037460) (hereinafter referred to as Porcari).

Regarding Claim 54:

Petruzzi and Tran do not disclose hyperlinks.

Porcari discloses wherein the incorporating comprises inserting into the statement a link to the document ([0056-58] – hyperlinks to identified documents).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the hyperlinks as taught by Porcari with the disclosure of Petruzzi and Tran so as to provide access to public and patent documents without having to provide paper copies.

Regarding Claim 55:

Porcari discloses wherein providing transmission of the statement comprises inserting into the document information from the linked document ([0056-0058] access would be through a web interface or URL link).

Regarding Claim 58:

Porcari discloses the interface is a web browser (Web-Based Document System).

Art Unit: 3629

9. Claims 11-14, 32, 34-36, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi and Tran as applied to claims 45 and 63 above, and further in view of Lee (US 6,662,178) (hereinafter referred to as Lee).

Regarding Claims 11-14, 32, 34-36 and 62:

Petruzzi discloses saving the statement in a database (col. 5, line 48 thru col. 6, line 7 and col. 16, lines 64-65 memory for receiving and storing data).

Petruzzi nor Tran disclose wherein the database is a local database in communication with a local computer network, wherein the database is a remote database in communication with the communication with the Internet.

However, Lee discloses wherein the database is a local database in communication with a local computer network (LAN), wherein the database is a remote database in communication with the communication with the Internet (col. 2, lines 58 thru col. 3, line 12, col. 3, line 24-35 (local and remote memory devices).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the databases as taught in Lee so as to allow for the creation and processing of search results which are run on local and remote database systems.

Regarding Claim 62:

Lee discloses downloading a document from the Internet (col. 3, lines 24-60 network – includes Internet, col. 4, lines 49-57- server makes the search results and any underlying documents available for viewing or other output by user).

Art Unit: 3629

Regarding Claims 11 and 36:

Lee discloses wherein the document is downloaded from a database coupled to a computer network (col. 3, lines 24-60 and col. 4, lines 30-57)

10. Claims 20 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi and Tran as applied to claim 45 and 63 above, and further in view of Takano et al (US 6,434,580) (hereinafter referred to as Takano).

Regarding Claims 20 and 41:

Petruzzi and Tran do not disclose generating a letter when the application information is filed with the patent office.

However, Takano discloses generating a letter via the computer when the application is filed in patent office (Figure 15, col. 37 thru col. 16, line 14, col. 16, lines 34-45 and Figure 18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transmittal of a letter as taught by Takano with IDS form of Petruzzi and Tran so as to provide notification and proof that the document was received by the patent office.

Art Unit: 3629

11. Claims 21-23 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi and Tran as applied to claims 45 and 63 above, and further in view of Hunter et al (US 6,298, 327) (hereinafter referred to as Hunter).

Regarding Claims 21-23 and 42-44:

Neither Pertruzzi nor Tran disclose a method or system wherein the electronic document is an electronic version of a US Patent, an electronic version of a foreign patent, or an electronic publication.

However, Hunter discloses a method and system wherein the electronic document is an electronic version of a US Patent, an electronic version of a foreign patent, or an electronic publication (col. 5 Table 2 Disclosure section prior art US patents, foreign patents, and publications).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the documents as taught in Hunter with the disclosure of Petruzzi and Tran since patentability includes a disclosure of all relevant documents.

Response to Arguments

Applicant's arguments with respect to claims 11-17, 19-23, 32-64 have been considered but are moot in view of the new ground(s) of rejection.

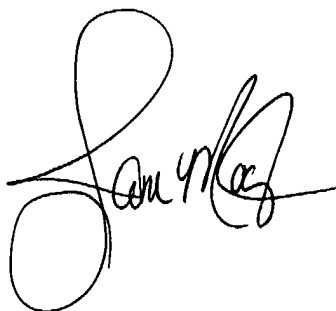
Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a large, stylized loop at the beginning.

Jan Mooneyham
Patent Examiner
Art Unit 3629